UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,263	09/28/2001	Mark Alan Bakke	98-017-TAX	4007

7590 03/30/2004

Wayne P. Bailey
Storage Technology Corporation
One StorageTek Drive, MS-4309
Louisville, CO 80028-4309

EXAMINER	
PERVEEN, REHANA	

ART UNIT	PAPER NUMBER
2182	4

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/966,263	BAKKE ET AL.	
	Examiner	Art Unit	
	Rehana Perveen	2182	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-7, and 10-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-7 and 10-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTC/SB/08) Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-7, and 10-18 are rejected under the judicially created doctrine of double patenting over claims 1-10 of U. S. Patent No. 6,330,621 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4-7, and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al, patent no. 5,546,557, in view of Molin, patent no. 6,111,944.

Allen et al and Molin were cited as prior art in the parent case and also cited in the IDS submitted herein.

As to claim 1, Allen et al teach a data storage manager operational in a data storage subsystem that uses a plurality of data storage elements to store data thereon for a plurality of host processors, means for storing a set of logical data storage device definitions that are created from the plurality of data storage elements, and means for identifying a set of data storage characteristics

appropriate for a present data object (figure 2, col. 9 lines 34-59 and col. 31 lines 51-63).

However, Allen et al do not **explicitly** teach means for comparing the identified set of data storage characteristics with the stored set of logical data storage device definitions, means for creating a new logical device definition using a plurality of the stored set of logical data storage device definitions responsive to a failure to match the identified set of data storage characteristics with a single one of the stored set of logical data storage device definitions, and means for storing the present data object on interconnected ones of the plurality of data storage elements that correspond to the new logical device definition.

Molin teaches means for comparing an identified set of device characteristics with a stored set of logical device definitions, means for creating a new logical device definition using a plurality of the stored set of logical device definitions responsive to a failure to match the identified set of device characteristics with a single one of the stored set of logical device definitions, and means for storing the present data object on interconnected ones of the plurality of device elements that correspond to the new logical device definition (figure 5, col. 3 line 50 - col. 4 line 40, and col. 6 lines 24-53).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine teachings of Allen et al and Molin since both are

commonly directed to creating logical device definitions and Molin's creating of the device definition upon comparison, match, and using a plurality of the stored set of logical device definitions, when incorporated into Allen et al's system, would have provided increased integrity and efficiency in Allen et al's system.

As to claim 4, Allen et al teach means for allocating space on an existing instance of the interconnected ones of the plurality of data storage elements that correspond to the new logical device definition (col. 9 lines 36-59).

As to claim 5, Allen et al, inherently, teach means for creating a new instance of the interconnected ones of the plurality of device elements that correspond to the new logical device definition.

As to claim 6, Allen et al, inherently, teach means for storing data indicative of a plurality of data storage attributes from the class of data storage attributes including speed of access to first byte, level of reliability, cost of storage, probability of recall, and expected data transfer rate.

As to claims 13 and 15, Allen et al and Molin, in combination, teach all of the limitations as stated above. In addition, Allen et al teach means for maintaining at least one storage attribute associated with a logical data storage device, said logical data storage device comprising at least a portion of the plurality of data storage elements (abstract).

As to claims 14 and 16, Allen et al teach the plurality of storage elements comprise physical and logical data storage elements (abstract and col. 38 lines 40-45).

Claims 7, 10-12, 17 and 18 are directed to the method of system claims 1, 4-6, and 13-16. Allen et al and Molin, in combination, teach the system claims 1, 4-6, and 13-16. Therefore, Allen et al and Molin, in combination, also teach the method claims 7, 10-12, 17, and 18.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rehana Perveen whose telephone number is 703-305-8476. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rehana Perveen
Primary Patent Examiner
Technology Center 2100